PATENT
Customer No. 81,331
Attorney Docket No. 10761.0194-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Michael G. MIKURAK	)	Group Art Unit: 3622
	)	
Application No. 09/444,774	)	Examiner: Arthur D. Duran
	)	
Filed: November 22, 1999	)	
	)	
For: ENHANCED VISIBILITY DURING INSTALLATION MANAGEMENT IN A NETWORK-BASED SUPPLY CHAIN ENVIRONMENT (as amended)	)	Confirmation No.: 9073

MAIL STOP: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests the review of the Final Office Action dated August 27, 2008, in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal, the required appeal fee, a Petition for Extension of Time of three (3) months, and the required extension of time fee.

REMARKS

The claims in this application stand rejected under 35 U.S.C. § 103(a). These rejections are appropriate for consideration under the Pre-Appeal Brief Conference

Program, as established at 1296 *Off. Gaz. Pat. Office* (July 12, 2005), because they are based upon a clear legal deficiency.

In the instant application, claims 70, 73-76, 82-87, 90-93, 99-104, 107-109, and 112-115 are pending. The Final Office Action mailed August 27, 2008 ("Final Office Action") rejects the claims under 35 U.S.C. § 103(a)[1]:

- Claims 70, 73-81, 87, 90-98, 104, and 107-111 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Webber (USP 6,167,378) (hereinafter *Webber*) in view of Whipple (USP 6,289,385) (hereinafter *Whipple*);
- Claims 82-84, 86, 99-101, 103, and 112-115 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Webber* in view of *Whipple* in view of Abgrall (USP 6,373,498) (hereinafter *Abgrall*); and
- Claims 85 and 102 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Webber* in view of *Whipple* in view of *Abgrall* in view of Gerace (USP 5,991,735) (hereinafter *Gerace*).

Clear error in these rejections is evidenced by the Examiner's reliance on mere conclusions in asserting *Webber* as a primary reference in the obviousness rejections. Applicant also submits that the Examiner failed to follow the procedure that is outlined in MPEP 2144.03 for relying on common knowledge.

In the Final Office Action, the Examiner has repeated the conclusion with little explanation that: "installation management is an obvious form of contracts managements that involves several parties . . . ." Final Office Action at 3, 7, and 16. MPEP 2144.03 states that "[i]n certain circumstances where appropriate, an examiner may take official notice of facts not in the record or rely on 'common knowledge' in making a rejection . . . ." Applicant respectfully submits that the Examiner has never taken Official Notice of the

[1] The Final Office Action also contains rejections of claims that had already been cancelled: For example, claims 77-81, 94-98, and 110-111 had previously been cancelled.

above-quoted conclusion, nor did the Examiner follow the procedure that is outlined in MPEP 2144.03 for taking Official Notice or for relying on "common knowledge."

A. The Examiner has not Provided A Technical Line of Reasoning That is Clear and Unmistakable.

Citation of facts unsupported by documentary evidence is governed by MPEP 2144.03:

> [T]he basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice so as to adequately traverse the rejection in the next reply after the Office action in which the common knowledge statement was made.

MPEP 2144.3. Applicant respectfully submits that the Examiner has not followed the above-quoted MPEP procedure. By simply stating his conclusion that installation management is a form of contracts management, the Examiner has neither provided "specific factual findings predicated on sound technical and scientific reasoning to support his . . . conclusion of common knowledge" nor presented Applicant "with the explicit basis on which the examiner regards the matter as subject to official notice so as to adequately traverse the rejection." MPEP 2144.03.

B. The Examiner's Conclusions Do Not "Defy Dispute."

MPEP 2144.03, quoting *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961), states that "the notice of facts beyond the record which may be taken by the

examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute.'" Applicant respectfully submits that it is not beyond dispute that "installation management of a service," as recited in each of the independent claims 70, 87, and 104, is an obvious form of contracts management. Indeed, Applicant respectfully submits that the installation management of a service, as recited in the claims, is NOT a form of the contracts management, especially the kind of contracts management that is described in *Webber.* As asserted in several of the above-cited responses to several Office Actions, Applicant submits that the contracts management in *Webber* involves contract fulfillment in a supply chain. The disclosed contracts management does not teach or suggest "installation management of a service." Therefore, the reliance by the Examiner on his conclusions in establishing *Webber* as the primary obviousness reference, is misplaced.

C. *The Examiner's Conclusions Do Not Merely "Fill In The Gaps" In The Rejections "In An Insubstantial Manner."*

According to MPEP 2144.03,

> [a]ny rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection.

MPEP 2144.03. Applicant respectfully submits that, without the Examiner's misplaced reliance on his conclusion that "installation management" is an obvious form of contracts management, *Webber* is a much less tenable reference in the Examiner's obviousness

rejection. Thus, the Examiner's reliance on his conclusion does more than "'fill in the gaps' in an insubstantial manner" in the Examiner's evidentiary showing for supporting his obviousness rejection. Applicant respectfully submits that the rejections based on the Examiner's misplaced conclusion are not judiciously applied. Accordingly, the rejections of these claims under 35 U.S.C. § 103(a) are clearly improper and should by withdrawn.

D. Conclusion

The rejections of the claims based on *Webber* are legally deficient as the Patent Office has failed to followed the procedures required by MPEP 2144.03 for relying on common knowledge as a basis of a rejection. The rejections of Applicant's claims 70, 73-76, 82-87, 90-93, 99-104, 107-109, and 112-115 under 35 U.S.C. § 103(a) clearly are erroneous, and Applicant respectfully requests that the panel reverse these rejections.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 27, 2009

By: _____
Maura K. Moran
Reg. No. 31,859